

## REMARKS

Claims 1 to 3 and 5 to 23 are currently pending in this application. By this paper, claim 8 has been amended.

In the Office Action, claim 8 was rejected under 35 U.S.C. Section 112 as being indefinite for lack of antecedent basis and for not providing the basis of measuring the required percentages. By this paper, Applicants have amended claim 8 to correct the lack of antecedent basis. With respect to the Examiner's position that the claim does not provide any basis of measuring the required percentages, Applicants respectfully submit that it is readily within the level of one of skill in the art to measure the percentages set forth in the amended claim. One skilled in the art can determine what portion of a feed boils above 370 °C and can readily determine that amount both before and after step (a). From this information, the percent that is converted to a lower boiling fraction can easily be calculated.

In the Office Action, claims 1 to 3 and 5 to 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahama et al. in view of Hamner et al. Applicants respectfully request reconsideration and withdrawal of this rejection.

The Nakahama et al. reference is directed to an ethylene-propylene-diene rubber, elastomer composition and vulcanized rubber thereof. The reference also teaches that softeners such as process oils and lubricating oils can be used as softeners.

The Hamner et al. reference discloses a process for the hydroisomerization of Fischer-Tropsch wax to produce a lubricating oil.

It was stated in the office action that it "would have been particularly obvious to one of ordinary skill in the art to select and incorporate the conventional process oils of Hamner et al. into the rubber compositions of Nakahama et al." While Applicants do not agree that it would have been obvious to combine the teachings of the two references, Applicants do contend that such a combination would not result in the claimed invention.

Each of the pending claims includes a limitation that the process oil has "a kinematic viscosity at 100 °C greater than 8 cSt." Applicants respectfully submit that Hamner neither teaches nor suggests an oil having these characteristics.

As set forth in Table 1 in column 9 of the Hamner reference, the dewaxed oils had a viscosity at 210 °F (about 99 °C) of 7.5 and 6.7. Accordingly, these oils are different than the process oil of the present invention which has a viscosity at 100 °C greater than 8

cSt. Thus, even if Nakahama and Hamner were combined, they would not produce the compositions of the present invention.

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance and favorable consideration by the Examiner is requested. Should the Examiner find any impediment to the allowance of the claims that could be corrected by telephone by the undersigned, the Examiner is requested to initiate such an interview.

Respectfully submitted,

VOLKER KLAUS NULL

By 

Their Attorney, Craig M. Lundell

Registration No. 30,284

(713) 241-2475

P. O. Box 2463  
Houston, Texas 77252-2463